

ELECTRONICALLY FILED

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of: )  
Hai H. Trieu ) Before the Examiner  
Application No.: 10/717,684 ) B. E. Snow  
Filed: November 20, 2003 )  
SYSTEMS AND TECHNIQUES FOR )  
INTERBODY SPINAL STABILIZATION ) Group Art Unit  
WITH EXPANDABLE DEVICES ) 3738  
Monday, November 10, 2008 )

**PETITION UNDER 37 CFR 1.144 TO WITHDRAW ELECTION REQUIREMENT**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The Director is respectfully requested to withdraw the election requirement issued in this case, for at least the reasons given below. All of the materials relevant to this Petition are already of record in the PTO file of this case, and the Director is requested to refer to it for documents relevant to this Petition.

In the current application, the Examiner made an election requirement that should be overturned. The requirement did not focus on the subject matter of the claims, and so is not properly formulated.

The claims in this case are method claims, concerning methods for intervertebral stabilization including multiple steps. The steps reflected in the language of the claims speak to placement and use of a number of physical elements, including an "expandable device" and an

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“expandable element” (independent claims 1 and 19), and a “motion preserving device” (independent claim 1). These independent claims also recite tissue adjustments such as “distract[ing] the disc space” and “restor[ing] a disc space height.” They are unmistakably method claims, defining a set of actions, not a set of structures.

“In passing upon questions of double patenting and restriction, it is the claimed subject matter that is considered and such claimed subject matter must be compared in order to determine the question of distinctness or independence.” MPEP 806.01. Although methods are the claimed subject matter in this case, the focus of the species-restriction analysis was on structure.

The election requirement (dated June 21, 2006) was directed to making several choices as to structures. Specifically, the requirement gave 15 different figures as allegedly “patentably distinct species of systems,” after separating out the “system” claims from the method claims in a restriction requirement. It then commanded the election of one of four allegedly “patentably distinct approaches,” and a single “device position,” referring to several device drawings.

In a later election requirement (dated March 15, 2006), the Examiner demanded election of “an ultimate embodiment of delivery device, expandable device, and motion preserving device for prosecution[,] fully describing said elected embodiment including shape and materials and specifically indicating what figures the elements are shown [sic].” The requirement alleged that unspecified species “are independent or distinct because the embodiments vary in structure, function, and/or capabilities; they have patentably distinct elements.”

Thus, although the claims were limited to methods, the election requirement focused on devices. The only possible methodological distinction argued in the requirement was among different directions of surgical approach. Those items should be rejoined, as noted below.

37 CFR 1.146 speaks of a “generic invention” and species of it in permitting restriction of species. “Species always refer the different embodiment of the invention.” MPEP 806.04(e) (emphasis added). Where the “invention,” i.e. the claim, is a method, the assessment with respect to species must determine whether there are species of the method, and then whether those species of method(s) are independent and distinct. Relying on structure to somehow prove that method species exist and are distinct loses sight of what the “invention” is.

The organization of the species election also points to its lack of focus on the claims. The election requirement saw Figures 33-34 (indicating the action of placing a motion preserving device) as part of a different species from Figure 1 and other drawings indicating steps recited in claim 1. This shows that the election requirement could not have been made based on the claims, since there was no set of figures grouped together in the requirement that showed all of the steps of claim 1. Species of “the invention” cannot be chosen so that no species embodies the entire subject matter of the relevant independent claim.

As noted above, only one possibly method-relevant distinction was drawn in the election requirement, focusing on direction of approach. This basis for restriction should be withdrawn as well, because there is insufficient evidence in the record to meet the PTO’s burden of showing independence and distinctness. Moreover, even if such independence and distinctness were to be shown, a determination should be made of record allowing them to be rejoined on allowance of a generic claim (such as claim 1). The recited approach directions are a reasonable number in the context of the surgical arts.

The original response (dated April 17, 2006) to the original election requirement included a traversal of this election requirement. That traversal was repeated in subsequent filings

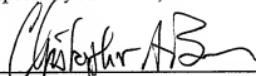
regarding the election requirement and in substantive prosecution of this application. Further, this Petition is being filed before or with a Notice of Appeal in this case. This Petition is therefore believed to be timely and proper.

No fees are being remitted with this Petition because none are believed to be due. If the Director believes that a fee is necessary for consideration of this Petition, he is authorized to charge it to Deposit Account No. 23-3030.

“Where the claims of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, restriction therebetween should never be required.” MPEP 806.03 (emphasis in original). The present application includes only method claims. An analysis of alleged species cannot be based on the structures and devices shown in the drawings because they are not “the invention”—the methods—indicated by the claims. Such an analysis does not demonstrate that there are different essential characteristics of method claims.

Accordingly, the Director is respectfully requested to withdraw the election requirement issued in this case, on the bases noted above. If the Director is unable to withdraw the portion of the requirement concerning approach directions, then it is respectfully requested that the Director state that those features can be rejoined on allowance of a generic claim.

Respectfully submitted,

  
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